

**REMARKS**

A reconsideration is requested of Claims 3-5, 7 and 23-24.

Claims 3-5, 7 and 23-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,769,816 to *Barbut et al.* Claims 3-5, 7 and 23-24 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,941,896 to *Kerr*.

The presently claimed invention pertains to a system useful for treating an aneurysm in a blood vessel of a mammalian patient, the aneurysm having a neck, a wall and a cavity. The system includes an elongated shaft having a proximal end, a distal end, a longitudinal direction defined between the proximal end and the distal end, and including at least one lumen extending therethrough. A self-expanding frame is positioned at the distal end of the shaft. The frame includes a plurality of self-expanding sections. Each of the plurality of self-expanding sections has an unbiased, expanded condition and a biased, collapsed condition. These features are defined in independent Claim 3.

Claim 3 has now been amended to also recite that each of the self-expanding sections is connected to an adjacent self-expanding section via a separate joint. Each of the plurality of self-expanding sections is foldable about the separate joint when in a biased, collapsed condition. None of the art of record discloses patentable features.

In contrast, *Barbut et al.* pertains to a cannula with associated filter for filtering blood. To start, *Barbut et al.* has nothing to do with a system for treating aneurysms, as defined in the preamble. Applicants submit that the preamble defines a different device

than the cannula with associated filter for filtering blood. The Examiner has failed to consider the preamble as a limitation.

It is well established that a preamble must be considered a limitation to the claim if "that language is essential to particularly point out the invention defined by the claims".

*DiversiTech Corp. v. Century Steps Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988)

(quoting *In re Bulloch*, 203 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). See also *Perkin-Elmer*

*Corp. v. Computervision Corp.*, 221 U.S.P.Q. 669, 675 (Fed. Cir.), *cert. denied*, 469

U.S. 857, 225 U.S.P.Q. 792 (1984) (the limitations appearing in the preamble are

necessary to give meaning to the claim and properly define the invention). That is, when

the claims depend "upon the preamble for life, vitality, and meaning... the limitations in

the preamble apply". *California Car Wash Systems, Inc. v. Danco, Inc.*, 184 U.S.P.Q.

13, 15 (N.D. Ga. 1974). Each case is different, and must be determined according to the

unique facts of the case. *In re Van Lint*, 148 U.S.P.Q. 285, 289 (C.C.P.A. 1966) ("the

significance of the preamble is something to be determined on the basis of the facts of each case").

Applied to the facts of the present case, the preamble of independent Claim 3 recites

a "system useful for treating an aneurysm in a blood vessel of a mammalian patient". The

preamble describes a unique device to which the claim alone refers. In contrast, the

primary reference relied upon by the Examiner discloses a "cannula for filtering blood".

The two devices are different, each having a unique meaning and understanding in the art.

Therefore, because the preamble gives life and meaning to the claims, it was impermissibly

ignored by the Examiner in rejecting the claims under 35 U.S.C. § 102(b) over *Barbut et al.*

In the leading case of *Kropa v. Robie and Mahlman*, 88 U.S.P.Q. 478 (C.C.P.A. 1951), the court summarized the principal reasons for considering the preamble as a limitation:

The applicant was the first to provide the article described in the introductory clause comprised of the elements recited in the remainder of the claim the existence of [the elements], while previously known was not obviously useful in the environment specified in the introductory clause, and which use solved a problem, the solution of which had been sought for years by the industry.

*Id.* at 486.

Another case on point is *In re DeNapoli and Balmer*, 133 U.S.P.Q. 556 (C.C.P.A. 1962). In that case, the decision of the Board of Appeals was reversed for failing to consider the patentable significance of the preamble of a claim to "a phonographic translating machine". The court noted that the preamble, together with the body of the claim referring to an adjustable mirror as reflecting an image "into a position to be visible to the transcribing typist... impart a limitation to the claim which cannot be ignored in determining patentability." *Id.* at 558. The court reasoned that (1) the limitations were not found in the prior art and (2) none of the prior art patents discloses the solution of the problems solved by the applicant. *Id.*

Here, it is indisputable that the limitations of independent Claim 3 are not identically disclosed by *Barbut et al.* The preamble of independent Claim 3 recites a

"system useful for treating an aneurysm in a blood vessel of a mammalian patient" which is a unique device from that of a cannula for filtering blood. The *Barbut et al.* patent makes absolutely no mention of a system useful for treating an aneurysm in a blood vessel of a mammalian patient, nor does it disclose the solution of the problem solved by the Applicant. Therefore, *Barbut et al.* fails to identically disclose the claimed subject matter of independent Claim 3, nor does it provide the solution of the problem solved by the Applicant. These factors should be considered by the Examiner.

Moreover, *Barbut et al.* fails to disclose that each of the self-expanding sections are connected to an adjacent self-expanding section via separate joints. In contrast, all of the alleged expanding sections converge to a common socket 34. Accordingly, *Barbut et al.* fails to disclose patentable features of independent Claim 3.

Likewise, *Kerr* relates to an apparatus for filtering blood, and has nothing to do with a system useful for treatment of an aneurysm, as defined in independent Claim 3. The two devices are different, each having a unique meaning and understanding in the art. Therefore, because the preamble gives life and meaning to the claims, it was impermissibly ignored by the Examiner in rejecting the claims under 35 U.S.C. § 102(e) over *Kerr*.

In addition, *Kerr* discloses that the expanding sections for filtering blood converge on a common point. Therefore, *Kerr* fails to disclose the feature that each of the self-expanding sections are connected to an adjacent self-expanding section via a separate joint, as now defined in independent Claim 3. As such, *Kerr* is not applicable to the system for treating an aneurysm as defined by the preamble.

For at least the foregoing reasons, it is submitted that the system as defined in independent Claim 3 and the claims depending therefrom is patentably distinguishable over the applied documents. Accordingly, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should any questions arise in connection with this application, or should the Examiner believe that a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

Respectfully submitted,

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